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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,602	06/23/2003	John R. Jackson	FC-10	8940
7590		08/31/2006	EXAMINER	
Andrew E. Pierce		WILKINS III, HARRY D		
161 McCracken Drive		ART UNIT		
Seneca, SC 29678		PAPER NUMBER		

1742

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/601,602

Applicant(s)

JACKSON ET AL.

Examiner

Harry D. Wilkins, III

Art Unit

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 03 July 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 8-17, 34 and 35.
Claim(s) withdrawn from consideration: 1-7 and 18-33.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Harry D. Wilkins, III
Primary Examiner
Art Unit: 1742

Continuation of 11. does NOT place the application in condition for allowance because: The Examiner does not find the Affidavit under 1.132 filed on 5 June 2006 persuasive with respect to the rejection grounds under 35 USC 112, 1st paragraph. In response, the Examiner continues to disagree. Applicant has not shown any example of a composition which meets the claimed "low alkali metal ion transport efficiency". One of ordinary skill in the art would not have been able to determine which membranes would infringe the claimed property without undue experimentation. A search of the prior art, and even the Internet, do not turn up any data on commercially available membranes as to the sodium ion transport efficiency, so this property would need to be tested for each and every membrane to determine if it were suitable. One of ordinary skill in the art would have not been able to make or use the invention commensurate in scope with the claims as Applicant has not provided examples of the membranes which meet the claimed sodium ion transport efficiency (especially the claimed sodium ion transport efficiency of claims 9-11). It also appears that Applicant may also be concealing the best mode of the invention since no example of the invention setting forth a membrane that is suitable for use (i.e.-meeting the claimed sodium ion transport efficiency) has been disclosed. What membrane is the Applicant using to achieve a sodium ion transport efficiency below 20%? Such membrane is certainly not disclosed by the specification as filed. Applicant has not shown that one of ordinary skill in the art would have been able to reasonably determine which cationic exchange membranes met the claimed property without undue experimentation. With respect to the first paragraph on page 4 of the affidavit, the assertion that modification of existing membranes by addition Teflon® (polytetrafluoroethylene) fibers was not disclosed in the specification. Applicant discloses (see page 14, lines 1-8 of the specification) merely that copolymers of vinyl monomers with perfluorovinyl monomers were suitable. As such, Applicant has failed to enable the claimed "low alkali metal ion transport efficiency" since it appears that not all such copolymers had the claimed property.